



TFN 1623

Docket No.: C035795/0125237

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :

Jerome O. CANTOR *et al.*

Serial No.: 09/863,849

Filed: May 23, 2001

For: **METHOD FOR TREATING
RESPIRATORY DISORDERS**

)
) Examiner: Michael C. Henry
)
) Art Unit: 1623

02/05/2007 HDEMESS1 00000034 024467 09863849

01 FC:2253 510.00 DA

New York, New York
February 1, 2007

**RESPONSE TO OFFICE ACTION INCLUDING
AMENDMENT AND PETITION FOR EXTENSION OF TIME**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action mailed August 2, 2006, which set a three-month shortened statutory period for response. A three-month extension of time to respond to the Office Action is hereby requested. Accordingly, this response is filed timely upon mailing, with an executed certificate of mailing, on or before February 2, 2007. 37 CFR § 1.8.

Prior to discussion of the rejections below, we note that, on January 30, 2007, a colleague of undersigned counsel, Charles M. Avigliano, Reg. No. 52,578, was reviewing a list of pending patent applications that are being prosecuted before the

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USPTO. Because our last response in this matter was filed in April 2006, and because we had not received any further actions from the PTO in this matter, a search was performed on the PAIR system of the USPTO. It was at that time we found that an Office Action had issued on August 2, 2006.

On January 31, 2007, undersigned counsel telephoned Examiner Henry and explained (i) that we had just found through PAIR that an Office Action had issued on August 2, 2006, (ii) that the August 2, 2006, Office Action was never received, and (iii) that the six month date for response is February 2, 2007. Thus, undersigned counsel requested that the Examiner either issue a new Office Action or restart the period for response. Later that day, Examiner Henry telephoned back and stated that he was told by his Supervisor not to issue a new Office Action and that the period for response would not be restarted.

In addition, and also by way of background, in our April 2006 response, we pointed out that this application had been pending for five years, and that the Examiner stated in the Office Action dated November 23, 2005, that he believed certain subject matter was allowable over the art. When the applicants accepted that administrative finding, the Examiner pulled his decision, and made a new ground rejection. Applicants explained their disappointment in the Examiner's decision to go against his prior finding, and pointed out that the term of a patent that will issue is being minimized by his piecemeal approach to prosecution. It was also explained in that response that the new rejection was no better than the last. As is apparent by the August 2, 2006, Office Action, the Examiner agreed and withdrew that rejection.

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However, the Examiner has continued piecemeal prosecution in the new Office action, and made another new rejection of a previously pending claim and similar subject matter. As explained again below, the new rejections also are insufficient as a matter of fact and law and should be withdrawn.

Finally, although it is not believed that an extension of time fee should be charged in view of the foregoing, if it is determined that a fee is due, please charge such fee (\$510.00; small entity) to Deposit Account No. 02-4467. A duplicate copy of this sheet is enclosed.

Please amend the application as follows:

AMENDMENTS TO THE CLAIMS are reflected in the listing of claims, which begin on page 3 of this paper.

REMARKS begin on page 7 of this paper.